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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,128

03/11/2004

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08/06/2008

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EXAMINER

ANWARI, MACEEH

ART UNIT

PAPER NUMBER

2144

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,128	Applicant(s) MUGUDA ET AL.	
	Examiner MACEEH ANWARI	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1- 3, 6-10, 12- 16 and 18- 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1- 3, 6-10, 12- 16 and 18- 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to communications file on 5/23/2008.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/2008 has been entered.

Information Disclosure Statement

3. The information disclosure statement filled on 3/11/2004, has been received and considered by the examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 1- 3, 6-10, 12- 16 and 18-25** recites the limitation "the group consisting of a job description and an expertise". There is insufficient antecedent basis for this limitation in the claim.

6. Furthermore regarding **claims 2, 10 & 16** they recite the limitation "the collaborative discussion". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1- 3, 6-10, 12- 16, and 18- 25** are rejected under 35 U.S.C. 102(b) as being anticipated by **Gross et al.** (hereinafter-**Gross**) U.S. Patent No.: 5,283,856.

Claim 1: A computer implemented method comprising:

receiving presentation content (Figures 1-2 and 6; e-mail) from an initiating client; identifying a plurality of users for which to participate in the presentation content (Figures 1-2, 6, 9 and 10A-B; e-mail messages, users and “To, From, CC, BCC” fields); distributing the presentation content to the identified plurality of users (Figures 1-2, 6, 9 and 10A-B; e-mail messages and sending them to users); after distributing the presentation content, receiving a first message from one of the plurality of users that includes a rule (Figures 1-2, 6, 9 and 10A-B; “To” field—address to where the message is being sent), the first message associated with the distributed presentation content but sent separately from the distributed presentation content (Figures 11- 11A; reply to the e-mail), wherein the rule includes a rule sentence that is selected from the group consisting of a job description and an expertise; (Figures 11- 11A; user and department); identifying a subset of the plurality of users that correspond to the rule (Figures 11- 11A; reply to the e-mail); forwarding the first message and the rule to the

identified subset of users (Figures 11- 11A; replying to the e-mail and forwarding the e-mail); receiving a second message and a modification of the forwarded rule from one of the identified users, wherein the modified forwarded rule includes a different rule sentence that is selected from the group consisting of a different job description and a different expertise; identifying one or more subsequent users that correspond to the modified forwarded rule; (Figures 1-9 and Abstract & Par. 40; mail messaging, users, rules and rule sets and attachments); and sending the second message and the modified forwarded rule to the one or more subsequent users that correspond to the modified forwarded rule (Figures 9-11 and Abstract & Col. 10 lines 44-51; mail messaging, users and sending messages).

Claim 2: Wherein the first message includes a comment, and wherein comment is displayed in the same display window as the collaborative discussion (Figures 9-11 and Abstract; mail messaging and message text).

Claim 3: Wherein the comment is displayed using display attributes corresponding to a rule pen, the rule pen that includes one or more rules, one of the rules being the forwarded rule (Figures 9-11 and Abstract; mail messaging, message text and rule, rule engine, rule editor and rule data base).

Claim 6: Wherein the rule sentence includes a rule sentence value, and wherein the rule sentence value is selected from the group consisting of a term, a

constant, a connective and a function (Figures 1-11A and Abstract & Col. 4 lines 33-45; rule set, rule data base and multiple functions).

Claim 7: Wherein the modifying includes changing the number of rule sentences that correspond to the rule (Figures 9-11 and Abstract; rule editor and multiple users).

Claim 8: Wherein the received message is sent from a sending client, the sending client adapted to select a rule pen from a rule pen stand, wherein the rule pen includes one or more rules, the forwarding rule being one of the rules (Figures 9-11A and Abstract & Col. 10 lines 44-51; rule, rule set, mail messaging, users, sending messages and users).

As per claims 9- 10 & 12- 14, the claims are directed to a system including substantially similar limitations to those recited in the method of **claims 1- 3 & 6- 8**. Therefore, the supporting rationale of the rejection to **claims 1- 3 & 6- 8** applies equally as well to **claims 9- 10 & 12- 14**.

As per claims 15-16 & 18- 20, the claims are directed to a computer operable medium including substantially similar limitations to those recited in the method of **claims 1- 3 & 6- 8**. Therefore, the supporting rationale of the rejection to **claims 1- 3 & 6- 8** applies equally as well to **claims 15-16 & 18- 20**.

As per claims 21-22, the claims are directed to a method including substantially similar limitations to those recited in the method of **claim 1**. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 21-22**.

As per claim 23, the claims are directed to a system including substantially similar limitations to those recited in the method of **claim 1**.

Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 23**.

As per claims 24-25, the claims are directed to a program product including substantially similar limitations to those recited in the method of **claim**

1. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 24- 25**.

Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

9. Applicant's arguments filed 5/23/2008 have been fully considered but they are not persuasive. In substance applicant argues:

10. That **Gross** never teaches “receiving a first message from one of the plurality of users that includes a rule, the first message associated with the distributed presentation but sent separately from the distributed presentation content.” In response to this the Examiner respectfully disagrees. **Gross** reads on these limitations by disclosing receiving a first message from one of a plurality of users (Figures 1-2, 6, 9 and 10A-B; e-mail message from initial sender) that includes a rule (Figures 1-2, 6, 9 and 10A-B; the rule as being—an address in the-- “To, From, CC, BCC” fields), the first

message associated with the distributed presentation but sent separately from the distributed presentation content (Figures 1-2, 6, 9 and 10A-B; e-mail message from the initial sender—as the *distributed presentation content*-- and replying or forwarding of the e-mail to others as well as the initial sender—as the associated with but sent separately).

11. That **Gross** does not disclose modifying a rule received from another user. The Examiner respectfully disagrees. **Gross** reads on this limitation by disclosing receiving a rule from another user (Figures 1-2, 6, 9 and 10A-B; the rule as being—an address in the-- “To, From, CC, BCC” fields), and furthermore **Gross** discloses sending/forwarding/replying to the e-mail with the same or different address and job description or expertise (Figure 11; the message from user: Joe and expertise: marketing).

12. Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

13. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows

multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

14. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly defines the claimed invention.

EXAMINER NOTE: It is recommended that Applicant should consider contacting the Examiner, and request a formal interview in order to expedite further proceedings and to address any questions or concerns that that maybe lingering.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

/Hassan Phillips/

Primary Examiner, Art Unit 2151